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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,789

Applicant(s)

LEE ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Amendment filed under 37 CFR §1.111 on Sept 05, 2006, claims 1, 5, 7, 15 and 20 have been amended. Claims 1-20 remain pending.

2. Amendment to claim 1 in response to previous rejection under second paragraph of 35 USC §112 *now* particularly point out subject matter *in accordance* with the invention's disclosure as filed. Specifically, claim limitation previously recited, "wherein the user terminal provides such advertising content simultaneously with the other content", however this seemed inconsistent with the written disclosure of the invention as filed, because according to the invention's disclosure the user terminal is provided advertising content simultaneously with the other content, thus, it does not provided advertising content simultaneously with the other content, as previously claimed. Rejection is hereby withdrawn.

Claim Rejection under 35 USC 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. At least claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In this case, claim (1) added limitations now recite, "...for merger at the user terminal to be conveyed to the user". There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96; however, with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02, and 2163.06. ("Applicant should specifically point out the support for any amendments made to the disclosure.") (see MPEP § 2163 B (II)). It is not clear where applicant points out to the corresponding support in the original disclosure providing column and lines thereto.

A. Applicant's remarks with respect to added limitation, which seems to be the basis of his/her argument have been fully considered. Applicant's remarks state:

The present invention, as recited in amended independent claims 1, 15, and 20, is patentable over the Thomas patent, since the present invention includes at least a decision maker module configured to select advertising content associated with at least one advertising campaign, based on user information including

Art Unit: 2142

consumer data specific to the user and obtained at least directly from a user terminal, so that the user terminal in communication with a server and to a separate resource provider receives other content from the resource provider and receives the selected advertising content corresponding to the user information retrieved by the first server, wherein the user terminal receives such advertising content and provides such advertising content simultaneously to the user with the other content for merger at the user terminal to be conveyed to the user. Briefly, the present invention is a distributed system in which advertising content and other content are merged from disparate sources in the user terminal for simultaneously conveyance to the user after merger at the user terminal (1ST-2ND paragraphs on page 11 of remarks)

However, applicant seems to fail to show support in the original disclosure for the newly added claim limitation. Specifically pointing out the support for the added limitation. It is not clear where applicant points out to the corresponding support in the original disclosure providing column and lines thereto. Nevertheless the specification has been reviewed for the merging aspect of the added limitation however it remains unclear where in the written disclosure this subject matter disclosed since the written disclosure seems to lack the use of the term “merger”.

B. Applicant's remarks with respect to the added limitation which seems to be the basis of his/her arguments have been fully considered. Applicant's remarks state:

The present invention employs separate data sources: the server which provides customized advertising content to the user terminal, and the resource provider, separate from and independent of the server, which provides other content to the user terminal. When a user access a webpage, the server supplies the advertising content, such as a banner ad, which is displayed on the retrieved webpage (1st paragraph on page 12 of remarks).

These remarks raise uncertainties with respect to what is actually claimed. Applicant's attention is directed to claim 1, which states: “a server operatively connected to a user terminal operated by a user, the server including:

an advertising administration module...

a user terminal interface module...

a decision maker module... “wherein the user terminal receives such advertising content and provides such advertising content simultaneously with the other content for merger at the user terminal to be conveyed to the user.” This claim limitation with respect to what is argued raises uncertainty, as to how does the user terminal receives and provides advertising content. This claim limitation seems to be in conflict with applicant's arguments, namely, “the server which provides customized advertising content to the user terminal, and the resource provider, separate from and independent of the server, which provides other content to the user terminal.”

It is respectfully noted that it is argued that the resources provider is “separate from and independent” of the server, yet what is claimed is that the server includes the service provider. This raises uncertainties as to what does “separate from and independent” really means or just how “separate and independent” can they really be.

Applicant argues “the server which provides customized advertising content to the user terminal, and the resource provider, separate from and independent of the server, which provides other content to the user terminal”,

Art Unit: 2142

yet what is claimed is that “provides advertising content simultaneously with the other content”. This raises uncertainties as to whether the user terminal receives the advertising content simultaneously with other content or

C. Applicant’s remarks with respect to the added limitation which seems to be the basis of his/her arguments have been fully considered. Applicant’s remarks state:

In the present invention, it is the resource provider such as the components 300a, 300b shown in FIG. 1a, which provides other content such as the bulk of the webpage separate from the banner ad. Such other content is not customized by the decision module of the present invention, while the advertising content is customized by the decision module of the present invention. In an example embodiment, referring to FIG. 1a, when a user accesses a webpage, for example, by entering a URL, the resource provider 300 connected to the user via the Internet 50 processes the URL to retrieve the appropriate webpage text and other content, while the server 100 processes the URL and other information obtained, for example, from an HTTP header associated with the URL and any cookie information associated with the user to customize the advertising content supplied for display to the user in the webpage, while the remainder of the other content on the webpage is obtained elsewhere.

However, applicant seems to fail to show support in the original disclosure for the newly added claim limitation. Specifically pointing out where (i.e. page, column and lines of the specs) *is the advertising content being merged with other content at the user terminal to be conveyed to the user*. The specification has been reviewed for the merging aspect of the added limitation, however it remains unclear where in the written disclosure this subject matter disclosed since the written disclosure seems to lack the use of the term “merger, merged or merging at the user terminal”.

D. Applicant’s remarks with respect to the added limitation which seems to be the basis of his/her arguments have been fully considered. Applicant’s remarks state:

Therefore, the merging of disparate content is performed by Thomas at a server outside of and separate from the user terminal, and then forwarded to the user terminal. In direct contrast with Thomas, *the present invention, the merging of disparate content is performed at the user terminal*. Therefore, the present invention is patentable over Thomas, since Thomas lacks all of the elements, steps, and features of the present invention, and since Thomas operates in a distinctly different manner from the present invention (see 2nd to 4th paragraph on page 13 of remarks).

However, applicant seems to fail to show support in the original disclosure for the newly added claim limitation. Specifically pointing out where (i.e. page, column and lines of the specs) *is the advertising content being merged with other content at the user terminal to be conveyed to the user*. The specification has been reviewed for the merging aspect of the added limitation, however it remains unclear where in the written disclosure this subject matter (i.e. “merging disparate content is performed at the user terminal”) disclosed since the written disclosure seems to lack the use of the term “merger, merged or merging at the user terminal”.

Art Unit: 2142

5. Regarding the merging aspect of the added limitation, it remains unclear where in the written disclosure this subject matter disclosed since the written disclosure seems to lack the use of the term "merger".

However, *applicant's attention is directed to the specification*, namely, the PGPUB version. Specifically,

[par 0034] an object dispatch module 160 stores a plurality of advertising objects, which are selectable to be displayed on a user's system.

[par 0035] Decision maker module 135 receives rules used by the decision module 135 to determines which object is displayed on the user's system from the plurality of objects identified in object dispatch module 160; [par 0042] the rules are for selecting advertising content based on info from the user.

[par 0038] the object dispatch module 160 is coupled to an HTML generator 165 in order to generate appropriate HTML templates that are populated by corresponding objects to be displayed to the user; where objects are data files corresponding to an item of merchandise that are displayed to a consumer. The object dispatch module 160 is also coupled to third party resource providers 300, which provide objects not stored internally in server 100.

[par 0039] server 100 also includes an modules 180 and module 182, both of which are coupled to HTML generator 165, the module 180 is configured to generate a small component of the advertising content, that is included with the HTML generator that is being sent to the user, the component includes a small object, invisible to the user, that is displayed along with the advertising content, the component also includes an executable (clickable) file, that invokes request to the server.

[par 0040] the module 182 also generates advertising content, that is included with the HTML generator that is being sent to the user; and displayed along with the advertising content; the component includes also clickable file/JavaScript e.g. clicks on the advertising content; [par 0041] functions of modules 108 and 182 can be one module.

[0075] the consumer interacts with touch point module 105 of server 100, downloads a web page from a website that has been previously modified so as to embed a request code to server 100 for a desired advertising campaign related to a participating merchant. As a result when that page is downloaded, the user's browser communicates with touch point module 105 in order to make a request for content corresponding to the advertising campaign so as to display the content in a designated area on the downloaded page, e.g. the designated area may be a location on the display where banner ads appear.

[par 0086] At step 445, based on the object number selected by decision maker module 135, object dispatch module 160 determines which resource is to be employed based on the selection from the decision maker module, the resources data is employed to fill the object template; the system may employ resources (data) which are stored internally, or else may provide a path to an externally stored resource; the stored rules associated with an object are employed to determine the appropriate resource to fill the object template.

Applicant is urged to point out where (i.e. page, column and lines or paragraph of the specs) *is the advertising content being merged with other content at the user terminal to be conveyed to the user*

The server's HTML generator seems to populated an HTML template (i.e. the web page) with objects to be displayed to the user, namely, objects from modules 180, 182 and resources providers 300. The user is provided a web page with advertising content e.g. a banner, which the user may click.

For the purposes of examination, the user terminal in communication with the server for receiving advertising content and other content simultaneously to the user terminal. The server being provided said other content by a resource provider, which provides said other content not internally stored on the server. The user terminal receives such advertising content simultaneously with other content to be displayed to the user. The server generates a data structure or page populated with the advertising content and the other content.

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "set out his uncommon definition in some manner within the patent disclosure" so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP § 2173.05(a).

For the purposes of examination, the user terminal in communication with the server for receiving advertising content and other content simultaneously to the user terminal. The server being provided said other content by a resource provider, which provides said other content not internally stored on the server. The user terminal receives such advertising content simultaneously with other content to be displayed to

Art Unit: 2142

the user. The server generates a data structure or page populated with the advertising content and the other content.

Claim Rejections - 35 USC § 103

6. Quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

7. Claims 1, 6-7, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US 6,128,663) in view of Eldering et al (US 6,820,277) (referred to as Eldering hereafter).

Regarding claims 1 and 20, Thomas teaches

a server operatively connected to a user terminal operated by a user, the server including: an advertising administration module, configured to maintain advertising content associated with at least one advertising campaign (col 1 lines 65-67, col 2, line 1), an advertising administration module, configured to maintain a plurality of advertising content associated with at least one advertising campaign (col 7, lines 48-55); said user terminal interface module configured to retrieve user information corresponding to said user terminal, for use by said advertising administration module (col 2, lines 45-50); said decision maker module configured to select one of said advertising content associated with at least one advertising campaign, based on said user information including consumer data specific to the user and obtained at least directly from said user terminal, so that the user terminal coupled to said server receives the selected advertising content corresponding to information retrieved by said server (col 2, lines 55-65). Thomas teaches a user terminal coupled to said server over the Internet (202) and thus to a separate resource provider (Fig. 2), and wherein the user terminal is provided said selected advertising content simultaneously with the other content, i.e. along with the other content (col 2, lines 51-63, and col 4, lines 53-65). Thomas does not explicitly teach of a user terminal interface module coupled to said advertising administration module nor a decision maker module coupled to said advertising administration module. In an analogous art, Eldering teaches on these aspects (col 5, lines 9-10, col 6, lines 5-10, fig 1) including

a resource provider separate from and independent of the server (Eldering see Fig. 1, the content provider is separate and independent from the system 100 implemented as a server column 9, line 66 to column 10, line 9, column 10, lines 51-54).

where the user terminal received such advertising content simultaneously with other content to be displayed by the user (Eldering column 9, lines 55-57, column 9, lines 18-37),

where the user terminal receives such advertising content simultaneously with other content downloaded to the user for “merger” at the user terminal by the discloses dynamic linking process, the advertisements are dynamically linked with the stream, thus ads contained with a multiplexed stream can be selected and directed to a viewer (see Eldering column 9, lines 18-37).

It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art (providing targeted advertisements to consumers). One of ordinary skill in the arts at the time of invention would have been motivated by the reasons discussed by Thomas (col 1, lines 60-65).

Regarding claim 15, comprises limitations similar to claim 1, same rationale of rejection is applicable. Thomas teaches: a server operatively connected to a user terminal operated by a user (col 1 lines 65-67, col 2, line 1), an advertising administration module, configured to maintain a plurality of advertising content associated with at least one advertising campaign (col 7, lines 48-55); said user terminal interface configured to retrieve user information corresponding to said user terminal, for use by said advertising administration module (col 2, lines 45-50); selecting one of said advertising content associated with at least one advertising campaign, based on said user information including consumer data specific to the user and obtained at least directly from said user terminal, wherein the consumer data specifically identifying the user and obtained at least directly from the user terminal is selected from the group of: the age of the consumer, the economic status of the consumer, and the language of preference of the consumer (col 11, lines 60-65, col 12, lines 10-15) so that the user terminal coupled to said server receives the selected advertising content corresponding to information retrieved by said server (col 2, lines 55-65); selecting the mode of appearance of said advertising content (col 2, lines 5-10, col 4, lines 5-10). However, Thomas does not explicitly teach a decision maker module coupled to said advertising administration module, nor a design user interface module configured to allow the user using the user terminal to specify a set of rules corresponding to an advertising campaign, said set of rules defining conditions for which specific advertising content is selected. In an analogous art, Eldering teaches an user terminal interface module coupled to said advertising administration module (col 5, lines 9-10) nor a decision maker module coupled to said advertising administration module (col 6, lines 5-10) nor a design user interface module configured to allow the user using the user terminal to specify a set of rules corresponding to an advertising campaign, said set of rules defining conditions for which specific advertising content is selected (col 5, lines 10-35). Refer to claim 1 for motivation.

Art Unit: 2142

Regarding claims 6-7, Eldering teaches of a memory unit that stores a set of rules corresponding to each of said advertising campaigns, said set of rules defining conditions for which specific advertising content is selected (col 5, lines 30-35, fig 1, item 102) and an information template flesh-out module coupled to said advertising maintenance module configured to retrieve information required by said rules (col 6, lines 1-20, fig 1).

8. Claims 2-5, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Eldering as applied to claim 1 above, and further in view of Parekh et. al. (US 6,757,740)

Regarding claims 2-5, and 17, Parekh teaching related to method for profiling Internet users (column 1, lines 20-25) teaches retrieving geographical location of said user terminal for use by said server (column 3, lines 2-4), wherein location include user terminal accessing services over the Internet, thereby location information consists of a metropolitan area, and wherein retrieving includes the specification of peripheral devices such as hardware specifications (column 3, lines 45-55 and Fig. 14b). It would have been obvious to one of ordinary skill at the time the invention was made to include Parekh's teachings for utilizing user specific information for modifying the content provided to the users based on said specific user data and/or information. One of ordinary skill would have been motivated in combining the teachings of Parekh with Thomas because in doing so online user can be targeted with content, advertising, or routed traffic depending upon the geographic locations of their online users/visitors. Additionally, to discussed obtained profile information, the central database can store visitor's preferences as to what content should be delivered to an IP address, the available interface, and the network speed associated with that IP address, as suggested by Parekh.

9. Claims 8-9, 10-14, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Eldering, as applied to claim 1 above, and further in view of Liu (US 6,839,680).

Regarding claims 8-9, and 10-14, Thomas does not teach tracking the time said advertising content is displayed and the amount of time, tracking the occurrence of a click through. Liu teaches tracking the time the advertising content is displayed on the user terminal (column 4, lines 36-40) and the amount of time, tracking the occurrence of a click through (column 12, lines 13-16, 40-45 and column 9, lines 30-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Liu's teachings for utilizing user specific information such as tracking the time said advertising

Art Unit: 2142

content is displayed and the amount of time, tracking the occurrence of a click through for modifying the content provided to the users based on said specific user data and/or information. One of ordinary skill would have been motivated in combining the teachings of Liu with Thomas because in doing it will overcome the limitations noted thereby in the prior art, and complement Thomas system by including an adaptive profile model of user's interests over time, wherein user's time based model of interests and group memberships forms a detailed profile of the Internet activity that can be used to market information and products to the user, to customize web content dynamically, or for other marketing purposes, as suggested by Liu.

Regarding claims 18-19, wherein said user information includes hardware specification of said user terminal (Liu: col 16, lines 30-35), wherein user information includes anonymous cookie profile information (Liu: col 16, lines 30-35), gender (Thomas: col 11, lines 53-67) and purchasing patterns (Liu: col 2, lines 62-65). Liu teaches of...configured to analyze response rate of each advertising (col 12, line 15, col 33, lines 50-65, col 34, lines 5-25).

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Eldering as applied to claim 15 above, and further in view of Welsh et al (US 6,757,691).

Regarding claim 16, neither Thomas nor Eldering explicitly teach where the weather conditions in a geographical location of said user terminal. In an analogous art, Welsh teaches of wherein said user information includes weather conditions in a geographical location of said user terminal (col 3, lines 40-45). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art (providing targeted advertisements to consumers). One of ordinary skill in the arts at the time of invention would have been motivated by the reasons discussed by Thomas (col 1, lines 60-65).

Response to Arguments

11. Regarding claims 1, 6-7, 15 and 20 rejected as being unpatentable over Thomas in view of Eldering, it is argued that the applied reference(s) do not teach claim limitation as amended. Specifically (p. 11 pf remarks), do not teach where the resource provider is separate from and independent of the

Art Unit: 2142

server, which provides other content to the user terminal. Because according to applicant's interpretation of the applied reference(s), the Thomas patent is single system of one server which returns both advertising content, such as banner ads, and other content, such as webpage text to the user terminal for display to the user.

In response to the above-mentioned argument, applicant's interpretation of the applied references has been carefully reviewed. However, Thomas teaches where the advertising content (306 of 3A) may provided on a remotely located third-party server, (column 7, lines 49-57, i.e. separate from server 300/204 of Fig. 3A) and where the identifying server (308/206 of Fig. 3B is separate from server 300/204 as shown of Fig. 3A) and thereby, also separate from remotely located third-party advertising content server, wherein the user terminal is provided said selected advertising content simultaneously with the other content, i.e. along with the other content (Thomas column 2, lines 51-63, column 4, lines 53-65). Thus, Thomas teaches a user terminal coupled to said server and to a separate resource provider.

Eldering teaches where the content provider and the advertising content provider are separate from the system 100 as shown on Fig. 1., where the AMS 100 is implemented on server based technology, where in one embodiment the portions of the system which interface to the Internet are based on Java and Java scripts (column 9, line 66 to column 10, line 9) and program streams (content) to which advertise content is inserted may be Internet web traffic or television programming (column 9, lines 10-12). Thus, Eldering teaches where the user terminal is coupled to a server and to a separate resource provider and/or where the user terminal is coupled to a server, where the resource provider is separate from the server.

12. Regarding claim 1, 6-7, 15 and 20 rejected as being unpatentable over Thomas in view of Eldering, it is argued that the applied reference(s) do not teach claim limitation as amended. Specifically (p. 11 pf remarks) providing advertising content simultaneously with the other content for merger at the user terminal.

In response to the above-mentioned argument, applicant's interpretation of the disclosed invention has been carefully reviewed. However, applicant seems to fails to show support in the original disclosure for the newly added claim limitation. Specifically pointing out where (i.e. page, column and lines of the specs) *is the advertising content being merged with other content at the user terminal to be conveyed to the user*. The specification has been reviewed for the merging aspect of the added limitation, however it remains unclear where in the written disclosure this subject matter disclosed since the written disclosure seems to lack the use of the term "merger, merged or merging at the user terminal".

The applied prior art teaches a resource provider separate from and independent of the server (Eldering see Fig. 1, the content provider is separate and independent from the system 100 implemented as a server column 9, line 66 to column 10, line 9, column 10, lines 51-54). The applied prior art teaches where the user terminal received such advertising content simultaneously with other content to be displayed by the user (Eldering column 9, lines 55-57, column 9, lines 18-37), the prior art also teaches where the user terminal receives such advertising content simultaneously with other content downloaded to the user for “merger” at the user terminal by the discloses dynamic linking process, the advertisements are dynamically linked with the stream, thus ads contained with a multiplexed stream can be selected and directed to a viewer (see Eldering column 9, lines 18-37).

13. Regarding claims 2-14 and 16-19 dependent from amended independent claims 1 and 15, respectively, and so includes the recitation of amended claims 1 and 15, respectively. It is argued (p. 14 of remarks) that “the present invention may have negligible but non-zero delays in sending both the advertising content and the other content to be combined in a single webpage requested by the user, since transmission limitations and physical distances between the server and resource providers may delay such synchronization and combination of advertising content and other content provided by the present invention to the user. One skilled in the art would not look to Thomas for the relatively slower system and configuration and operation of components of the present invention, since the present invention sacrifices speed for the ability to provide more dynamic customization of the advertising content for the combination of such advertising content and other content compared to the system of Thomas.”

In response to the argument, the above advantages have been fully considered, however this argument does not seem to be commensurate with the scope of what is claimed. Since the features upon which applicant relies (i.e., “possible negligible but non-zero delays in sending both the advertising content and the other content to be combined in a single webpage requested by the user”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Applicant’s arguments filed with the above-mentioned amendment have been fully considered but not found persuasive.

Art Unit: 2142

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Hand carried or delivered to:

Customer Service Window located at the Randolph Bldg.
401 Dulany St.
Alexandria, VA 22314

Faxed to the Central Fax Office:

(571) 273-8300 (New Central Fax No.)

Or Telephone:

(571) 272-2100 for TC 2100 Customer Service Office.

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER